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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,731	02/15/2002	Ken Pallett	514413-3915	4744

20999 7590 12/27/2005
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

CLARDY, S

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/049,731	PALLETT, KEN	
	Examiner	Art Unit	
	S. Mark Clardy	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-41 and 60-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 99 is/are rejected.
- 7) ☒ Claim(s) 23-41, 60-98, 100 and 101 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/30/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 23-41 and 60-101 are pending in this application.

Applicant's elected species is the composition comprising the benzoylisoxazole herbicide isoxaflutole¹ (compound A), in combination with the diphenylisoxazolecarboxylic acid safener isoxadifen². The elected species had been expanded previously to include any safener in combination with the elected herbicide, isoxaflutole, or carboxylate derivatives thereof. The elected species has been further expanded to encompass applicant's isoxazolyl herbicides (A is A-1 or A-2) and diketonitrile herbicides (A is A-3). No claims remain withdrawn from examination.

Prior to initiating interference proceedings with the two Rüegg patents (US 6,489,267 and 6,746,987), the following formal matters need to be corrected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 99 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The R¹ substituent is not defined; it appears that it should be the same as that in claim 63. However, see the following provisional duplicate claim objection.

Claim 99 is provisionally objected to under 37 CFR 1.75 as being a substantial duplicate of claim 38 (composition claims, ester safener). The claim is provisionally objected to because it appears that the R¹ definition, which has been incorrectly omitted, should be the same as that in claim 63, in which case the claims will be identical in scope. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight

¹ Isoxaflutole: 5-cyclopropyl-4(2-methylsulfonyl-4-trifluoromethylbenzoyl)isoxazole

² Isoxadifen: 5,5-diphenylisoxazoline-3-carboxylic acid

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difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 100 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 27 (method claims, ester safener) . When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 70 and 97 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 28 (method claims, acid safener). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 101 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 81 (method claims, ester safener, on maize). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 71 and 98 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 84 (method claims, acid safener, on maize. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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Claims 41 and 69 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 39 (composition claims, acid safener). When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).


Claims 23-41 and 60-101 are objected to under 35 USC 135(a) as claiming the same subject matter of US Patents 6,489,267 and 6,746,987 to Rüegg. These claims would be allowable, but for the issuance of these patents which discloses the combination of applicant's isoxaflutole in combination with isoxadifen acid and ester, respectively.

Upon receipt of an amendment correcting the R¹ definition of claim 99, and removing duplicate claims, an interference will be declared with the Rüegg patents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Mark Clardy
Primary Examiner
Art Unit 1617

December 21, 2005